

REMARKS

Claims 1-10, 12-38, 43, 45, and 46 are pending in this application.

Applicant has amended claims 1, 12-14, 25-38, 45, and 46. The changes to the claims made herein do not introduce any new matter.

Applicant respectfully requests reconsideration of the rejection of claims 1-10, 12-24, 29-38, 43, and 46 under 35 U.S.C. § 112, second paragraph. Applicant has amended the claims to address the Examiner's indefiniteness concerns. Accordingly, Applicant submits that claims 1-10, 12-24, 29-38, 43, and 46 now satisfy the definiteness requirement of 35 U.S.C. § 112, second paragraph, and requests that the rejection of these claims thereunder be withdrawn.

Applicant respectfully requests reconsideration of the rejection of claims 1-10, 12-38, 43, 45, and 46 under 35 U.S.C. § 101 because "the claimed invention is directed to non-statutory subject matter." Office Action at page 3. Applicant has amended claims 12, 28, and 38 so that these claims define a computer-readable medium encoded with a computer program. Accordingly, the aspect of the section 101 rejection based on claims 12, 28, and 38 specifying merely a "computer-executable program" has been addressed.

The remaining section 101 issues cited by the Examiner relate to whether the claims define subject matter that produces "a concrete, useful, and tangible result." Office Action at page 3. Applicant respectfully submits that each of the image data generating devices, computer-readable media, methods for generating image data, output control devices, and methods for outputting image data defined in the claims produces a concrete, useful, and tangible result that forms the basis of statutory subject matter under 35 U.S.C. § 101. In support of this position, Applicant refers the Examiner to pages 34-41 of the Informative Opinion of the Board of Patent Appeals and Interferences in *Ex parte Bilске et al.*, Appeal No. 2002-2257 (available at: <http://www.uspto.gov/web/offices/dcom/bpai/its/fd022257.pdf>).

Accordingly, Applicant submits that claims 1-10, 12-38, 43, 45, and 46 define allowable subject matter under 35 U.S.C. § 101, and requests that the rejection of these claims thereunder be withdrawn.

Applicant respectfully requests reconsideration of the rejection of claims 1-3, 9, 12-16, 22, 24-30, 33-35, 38, 43, 45, and 46 under 35 U.S.C. § 102(b) as being anticipated by *Ishii et al.* (U.S. Patent No. 5,982,416). As will be explained in more detail below, the *Ishii et al.* reference does not disclose each and every feature specified in independent claims 1, 12-14, 25-29, 33, 34, 38, 45, and 46, as amended herein.

Considering first independent claim 1, Applicant has amended this claim to specify that the “output control data” designates the image processing conditions to be carried out by each of the plurality of output devices. Thus, as defined in claim 1, the claimed subject matter outputs the output control data that designates the output conditions for each of a plurality of output devices, together with a corresponding piece of image data, from an imaging device to one or more of the output devices. In contrast, the *Ishii et al.* reference discloses a color matching technique, and this technique is characterized by transmitting the so-called ICC profile type of information together with image data from an imaging device to a host computer.

The claimed subject matter differs from that shown in the *Ishii et al.* reference in at least the following two respects:

- 1) the output control data is usable in a plurality of output devices (the *Ishii et al.* reference relates the image data to data from only one profile); and
- 2) the output condition of an output device is designated by an imaging device (the *Ishii et al.* reference relates a color space profile of an imaging device to image data).

Regarding item 1), the *Ishii et al.* reference discloses a profile storage unit 15 in Figure 1, and this profile storage unit stores multiple profiles relating to multiple output

devices. These profiles, however, are merely the same profiles previously stored in host computer 10.

Regarding item 2), the *Ishii et al.* reference fails to disclose outputting profile data of an output device from an input device. Rather, the *Ishii et al.* reference uses an up-to-date input color space profile that is used by an imaging device so as to carry out more appropriate color conversion, as compared with a conventional technique which uses a color space profile stored in an image processing device.

For at least the foregoing reasons, the *Ishii et al.* reference does not disclose each and every feature of the image data generating device defined in independent claim 1, as amended herein. Accordingly, claim 1 is patentable under 35 U.S.C. § 102(b) over *Ishii et al.* Claims 2, 3, 9, and 43, each of which depends from claim 1, are likewise patentable under 35 U.S.C. § 102(b) over *Ishii et al.* for at least the same reasons set forth above regarding claim 1.

Shifting to the other independent claims included in the anticipation rejection, namely claims 12-14, 25-29, 33, 34, 38, 45 and 46, Applicant has amended these claims along the lines discussed above with regard to claim 1. Applicant respectfully submits that the arguments set forth above regarding claim 1 apply equally to the other independent claims included in the anticipation rejection because these claims specify the same or similar features, albeit in different contexts, e.g., independent claims 12, 28, and 38 define a computer-readable medium and independent claims 14, 27, 34, and 46 define a method for generating image data to be outputted by one or more of a plurality of output devices. Accordingly, independent claims 12-14, 25-29, 33, 34, 38, 45, and 46 are patentable under 35 U.S.C. § 102(b) over *Ishii et al.* for at least the same reasons set forth above regarding claim 1. Claims 15, 16, 22, and 24, each of which depends from claim 14, claim 30, which depends from claim 29, and claim 35, which depends from claim 34, are likewise patentable under 35

U.S.C. § 102(b) over *Ishii et al.* for at least the same reasons set forth regarding the applicable independent claim.

Applicant respectfully requests reconsideration of the rejection of claims 4-8, 10, 17-21, 23, 31, 32, 36, and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Ishii et al.* in view of *Kohler et al.* (U.S. Patent No. 5,646,752). Each of the claims included in this obviousness rejection depends from one of the independent claims that has been rejected under 35 U.S.C. § 102(b) as being anticipated by *Ishii et al.* The *Kohler et al.* reference has been cited by the Examiner merely to show the feature of identifying a classification selected from a group of classifications, and does not cure the above-discussed deficiencies of the *Ishii et al.* reference relative to the claimed subject matter, as presented herein. Accordingly, claims 4-8, 10, 17-21, 23, 31, 32, 36, and 37 are patentable under 35 U.S.C. § 103(a) over *Ishii et al.* in view of *Kohler et al.* for at least the reason that they ultimately depend from one of independent claims 1, 14, 29, and 34.

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of claims 1-10, 12-38, 43, 45, and 46, as amended herein, and submits that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any

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additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP003).

Respectfully submitted,
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A handwritten signature in black ink, appearing to read 'Peter B. Martine', with a long horizontal line extending to the right.

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